

REMARKS

Claims 1-8 are under consideration.

Rejection under 35 USC 103

Claims 1-8 were rejected under 35 USC 103(a) as being unpatentable over Scharschmidt (US 3,615,677) in view of Martinez-Bustos (US 5,532,013) for the reasons stated in the previous Office Action mailed December 11, 2007. For the reasons that follow, Applicants respectfully traverse.

Applicants traverse the rejection of claims 1-8 under 103(a) because the Applicants submit that the factual analysis put forth in the Office Action is flawed because the Examiner has failed to adequately make out a prima facie of obviousness by determining the scope and content of the prior art as required under Graham v. John Deere Co., 383 US 1, 148 USPQ 459 (1966). Furthermore, under MPEP § 2141.02 (I), in determining the differences between the prior art and the claims, the question under 35 USC § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Under MPEP 2141.02 (VI), a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Moreover, MPEP § 2142 additionally states that the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR. (quoting Federal Circuit statement with approval). Thus, the Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness, which has not been done.

Specifically in the present application, Applicants submit that independent claims 1 and 8 patently define over the asserted combination of Scharschmidt (US 3,615,677) in view of

Martinez-Bustos. The Examiner recognizes that Scharschmidt is silent as to using calcium hydroxide but attempts to make up for that deficiency by using the teachings of Martinez-Bustos. However, this combination is inappropriate for the following reasons.

Firstly, no motivation to combine Scharschmidt with Martinez-Bustos has been given. A reason to combine the references and result in the invention as claimed, without hindsight analysis, is needed. KSR teaches that there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” Id. Scharschmidt is concerned with improvements in the products of spaghetti, macaroni, noodles, and the like using corn flour and soy flour. Martinez-Bustos is concerned with the manufacture of fresh corn masa, which is used for the producing of corn tortillas. Thus, while both are concerned generally with corn, the similarities end there as Scharschmidt is concerned with using corn flour in combination with other flours to make pasta products like spaghetti, macaroni, and noodles, while Martinez-Bustos is specifically looking at corn masa for use in corn tortillas. One of ordinary skill in the art looking to process corn flour and soy flours mixtures as in Scharschmidt would not look to a corn masa process for making corn tortillas as in Martinez-Bustos. Moreover, Martinez-Bustos discloses the importance of using nixtamalization, which is the process of combining water and lime with the dough at elevated temperatures, while Scharschmidt is completely silent regarding any such processing conditions. Additionally, the only disclosure in Scharschmidt regarding any pH agent is in Example III, in which calcium carbonate is mixed with water to form a paste. Absolutely no disclosure or discussion exists with respect to why the calcium carbonate is used or whether any substitution for it could occur. Thus, no motivation to look to Martinez-Bustos for a corn masa dough using nixtamalization would exist because Scharschmidt is not concerned whatsoever with corn masa dough or the properties of nixtamalization. Reconsideration and withdrawal of the rejection are respectfully requested.

Secondly, and even more importantly, it is respectfully submitted that even if one of ordinary skill in the art would look to Martinez-Bustos, that reference specifically and directly teaches away from the present invention. The present application specifically teaches non-steeped corn blends and non-steeped methods and does so in the presently pending claims. Importantly and critically, Martinez-Bustos teaches nixtamalized corn dough and high temperature processing of the doughs (see throughout the patent, including column 1, line 8, column 7, line 20 and 58, and column 8, line 7). Thus, since the present application specifically claims non-

Appl. No. 10/806,555
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steeped corn blends and methods not including steeping, one of ordinary skill in the art would not consider or even look to Martinez-Bustos since it specifically and directly teaches nixtamized corn dough. One of ordinary skill in the art producing and processing non-steeped materials would not look to opposite materials and methods, as those materials and methods teach away from the materials and methods claimed. Thus, since under MPEP 2141.02 (VI), a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention, Martinez-Bustos should be removed as a reference from further consideration. Thus, respectful reconsideration and withdrawal of the rejection as improper are respectfully requested.

CONCLUSION

In view of the above remarks, it is submitted that the present application is now in condition for allowance, and the Examiner is requested to pass the case to issue. If the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicants' undersigned representative.

Respectfully submitted,

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